

PTO/SB/97 (08-03)

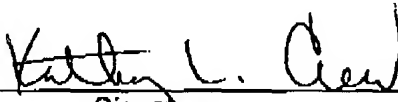
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MAY 27 2004

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10/625227
PI1270USCNTResponse to Restriction Requirement
3 Mos. Extension of Time
Fee Sheet
Deposit Account Authorization
Certificate of Transmission

This collection of information is required by 37 CFR 1.8. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1.8 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Attorney Docket No. PI1270 US CNT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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MAY 27 2004

In re U.S. Patent Application of:

Helen S.M. Lu, et al.

Group Art Unit: 1621

Serial No.: 10/625,227

Examiner: Michael L. Shippen

Filing Date: July 23, 2003

Confirmation No: 8629

OFFICIAL

Title: 3-ALKYLATED-5,5',6,6',7,7',8,8'-OCTAHYDRO-2,2'-BINAPHTHOLS AND 3,3'-
DIALKYLATED-5,5',6,6',7,7',8,8'-OCTAHYDRO-2,2'-BINAPHTHOLS AND PROCESSES
FOR MAKING THEM

MAIL STOP AMENDMENT
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

**RESPONSE TO RESTRICTION REQUIREMENT
UNDER 35 U.S.C. § 121**

Sir:

The present communication is responsive to an Office Action dated January 28, 2004 in the above-captioned application (the "Application") requiring a restriction of the claims submitted for examination. A petition for a three (3) months extension of time in which to file this response along with the requisite fee is filed herewith.

Claims 1-19 are currently pending in the Application. In the Office Action, it was asserted that the Application contains claims which are directed to distinct inventions. As a result, the Examiner issued a Restriction Requirement requiring the election of a single group of claims for prosecution.

U.S. Patent Application No. 10/625,227

The claims, as grouped by the Examiner, appear as follows:

- I. Claims 1 and 18, drawn to compounds, classified in class 568, subclass 719.
- II. Claims 2-11, drawn to processes using an alkene reactant, classified in class 568, subclass 719.
- III. Claims 12-14, drawn to processes using a halide reactant, classified in class 568, subclass 719.
- IV. Claims 15 and 16, drawn to processes using sulfonate reactant, classified in class 568, subclass 719.
- V. Claim 17, drawn to a process using an alcohol reactant, classified in class 568, subclass 719.

Applicants respectfully traverse the Restriction Requirement.

Initially, Applicants note that the Application was filed with 19 claims, although only 18 claims are listed as pending in the Office Action. Claim 19 is dependent from claim 18 and Applicants therefore respectfully submit that Claim 19 should have been included in the claims designated as Group I.

The Examiner states that the inventions are distinct, each from the other because the claims of Groups I and II, III, IV or V are related as process of making and product made. According to MPEP § 806.05(f), the inventions are distinct if it can be shown either that (1) the process as claimed can be used to make other and materially different products, or (2) the product can be made by another and materially different process. The Examiner asserts that the processes can be used to make compounds outside of the claims of Group I and that the claims of Groups II-V evidence that the product may be prepared by more than one process. Office Action at pg. 2.

U.S. Patent Application No. 10/625,227

Under the patent statute, 35 U.S.C. § 121, an application may be properly required to be restricted to one of two or more claimed inventions, only if they are able to support separate patents and they are either independent or distinct. 37 C.F.R. § 1.141; MPEP § 803. However, if the search and examination of an entire application can be made without serious burden, then the examiner must examine it on the merits, even if it includes claims to distinct or independent inventions. MPEP § 803. Here, all five groups of claims are all classified in the same class and subclass: class 568, subclass 719. Thus, Applicants respectfully submit that a search of patent documents would not constitute a serious burden on the Examiner.

The Examiner asserts that despite identical classification, the search would require a divergent search of the literature. Office Action at pg. 3. However, Applicants note that in addition to the same classification, all groups of claims contain a common reactant (5,5',6,6',7,7',8,8'-octahydro-2,2'-binaphthol). Furthermore, the claims of Groups II-V include the limitation of an acid catalyst. Thus, Applicants submit that even a literature search would not be as burdensome as suggested by the Examiner.

Applicants respectfully submit that a five-way restriction is a severe measure, particularly in light of the limited number of claims (19) and the overlapping nature of the subject matter as demonstrated by the identical classifications of all five groups of claims. In light of the foregoing, Applicants respectfully request the Examiner reconsider the Restriction Requirement.

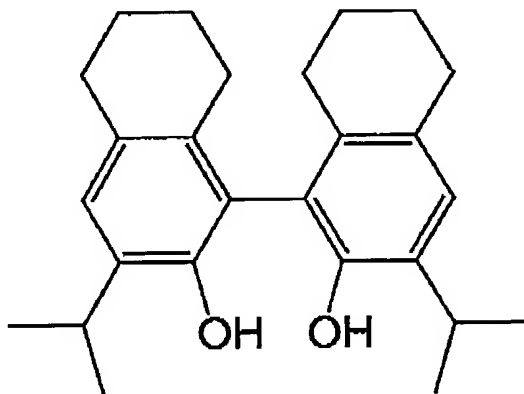
Notwithstanding the above, in order to comply with the Restriction Requirement, Applicants elect with traverse the claims of Group I. Applicants further request that the remaining claims be held in abeyance under the provisions of 37 C.F.R. § 1.142(b) until final disposition of the elected claims. In electing Group I, Applicants again note that claim 19 was omitted from the claims as grouped by the Examiner in the Office Action. However, Applicants

U.S. Patent Application No. 10/625,227

respectfully submit that because claim 19 is dependent from claim 18, claim 19 should also be examined with the claims of Group I.

The Examiner has further indicated that if the claims of Group I are elected, that Applicants "must provisionally elect a single disclosed and claimed species, i.e. a single compound." Office Action at pg. 3. It is asserted by the Examiner that the members of the Markush groups of claims 1 and 18 are so unrelated and diverse that a prior art reference anticipating the claims with respect to some members would not render the claims obvious under 35 U.S.C. § 103 with respect to all of the other members. *Id.*

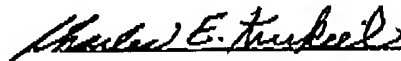
As Applicants have elected Group I, Applicants provisionally elect the compound of claim 1 designated by formula 2, wherein R is an isopropyl group. The elected compound reads on all of the claims of Group I and has the structural formula as shown:



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If the Examiner has any questions regarding the election of the claims of Group I or the elected species, the Examiner is invited to contact Applicants' undersigned representative for a telephone conference to resolve such questions in an expeditious manner.

Respectfully submitted,



INVISTA, North America S.à.r.l
4417 Lancaster Pike
Intellectual Property - Bldg. 722/WR1032
Wilmington, Delaware 19805
Tel.: (302) 999-3708
Fax: (302) 999-3881

Charles E. Krukiel
Attorney for Applicants
Registration No. 27,344

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of:

HELEN S.M. LU, ET AL.

CASE NO.: PI1270USCNT

APPLICATION NO.: 10/625,227

GROUP ART UNIT: 1621

FILED: JULY 23, 2003

EXAMINER: MICHAEL L. SHIPPEN

FOR: 3-ALKYLATED, 5,5',6,6',7,7',8,8'-OCTAHYDRO-2,2'-BINAPHTHOLS AND
3,3'-DIALKYLATED-5,5',6,6',7,7',8,8'-OCTAHYDRO-2,2'-BINAPHTHOLS
AND PROCESSES FOR MAKING THEM

DEPOSIT ACCOUNT AUTHORIZATION

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Should any fee be required in connection with the filing of the attached Response to
Restriction Requirement Under 35 U.S.C. 121 and the Petition for Extension of Time Under 37 CFR
1.136(a), please charge such fee to Deposit Account No. 03-1165 (INVISTA North America S.à.r.l –
formerly KoSa).

Respectfully submitted,



Deanna M. McGregor
Authorized User
Telephone: (302) 999-3944
Facsimile: (302) 999-3881

Dated: May 27, 2004

PTO/SB/17 (10-03)

Approved for use through 07/31/2006, OMB 0851-0032

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 950.00

Complete if Known

Application Number 10/625227
 Filing Date July 23, 2003
 First Named Inventor Helen S. Lu Et. Al.
 Examiner Name Michael L. Shippen
 Art Unit 1621
 Attorney Docket No. PI1270USCNT

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None
☒ Deposit Account:
 Deposit
 Account
 Number
 Deposit
 Account
 Name

03-1165

INVISTA North America S.a.r.l

The Director is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments☒ Charge any additional fee(s) or any underpayment of fee(s)☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1001 770	2001 385	Utility filing fee	
1002 340	2002 170	Design filing fee	
1003 530	2003 265	Plant filing fee	
1004 770	2004 385	Reissue filing fee	
1005 160	2005 80	Provisional filing fee	
SUBTOTAL (1) (\$)			0.00

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Extra Claims	Fee from below	Fee Paid
Independent Claims	-20** =	X 18	
Multiple Dependent Claims	-3** =	X 66	
Multiple Dependent YES			290.00

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1202 18	2202 9	Claims in excess of 20	
1201 66	2201 43	Independent claims in excess of 3	
1203 290	2203 145	Multiple dependent claim, if not paid	
1204 66	2204 43	** Reissue independent claims over original patent	
1205 18	2205 9	** Reissue claims in excess of 20 and over original patent	
SUBTOTAL (2) (\$)			0.00

**or number previously paid, if greater. For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Small Entity

Fee Code (\$)	Fee Code (\$)	Fee Description	Fee Paid
1051 130	2051 65	Surcharge - late filing fee or oath	
1052 50	2052 25	Surcharge - late provisional filing fee or cover sheet	
1053 130	2053 130	Non-English specification	
1812 2,520	1812 2,620	For filing a request for ex parte reexamination	
1804 820*	1804 920*	Requesting publication of SIR prior to Examiner action	
1805 1,840*	1805 1,840*	Requesting publication of SIR after Examiner action	
1251 110	2251 55	Extension for reply within first month	
1252 420	2252 210	Extension for reply within second month	
1253 850	2253 475	Extension for reply within third month	850.00
1254 1,480	2254 740	Extension for reply within fourth month	
1255 2,010	2255 1,005	Extension for reply within fifth month	
1401 330	2401 165	Notice of Appeal	
1402 330	2402 165	Filing a brief in support of an appeal	
1403 290	2403 145	Request for oral hearing	
1451 1,510	1451 1,510	Petition to institute a public use proceeding	
1452 110	2452 55	Petition to revive - unrevocable	
1453 1,330	2453 665	Petition to revive - unintentional	
1501 1,330	2501 665	Utility issue fee (or reissue)	
1502 480	2502 240	Design issue fee	
1603 640	2503 320	Plant issue fee	
1460 130	1460 130	Petitions to the Commissioner	
1807 50	1807 50	Processing fee under 37 CFR 1.17(a)	
1808 180	1808 180	Submission of Information Disclosure Stmt	
8021 40	8021 40	Recording each patent assignment per property (times number of properties)	
1809 770	2809 385	Filing a submission after final rejection (37 CFR 1.128(a))	
1810 770	2810 385	For each additional invention to be examined (37 CFR 1.128(b))	
1801 770	2801 385	Request for Continued Examination (RCE)	
1802 900	1802 900	Request for expedited examination of a design application	

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$) 950.00

SUBMITTED BY

Name (Print/Type)

Deanna McGregor

Signature

Deanna McGregor

Registration No.

(Attorney/Agent)

(Complete if applicable)

Telephone

302-999-3944

Date

May 27, 2004

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